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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/739,208	12/18/2003	Daniel Kuzmich	9/272	1223
28509	7590	09/14/2007		
MICHAEL P. MORRIS BOEHRINGER INGELHEIM CORPORATION 900 RIDGEBURY ROAD P O BOX 368 RIDGEFIELD, CT 06877-0368			EXAMINER SEAMAN, D MARGARET M	
			ART UNIT 1625	PAPER NUMBER
			MAIL DATE 09/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/739,208

**Applicant(s)**

KUZMICH ET AL.

**Examiner**

D. Margaret Seaman

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's request for reconsideration of the finality of the rejection of the last Office (dated 3/14/2007) action is persuasive and, therefore, the finality of that action is withdrawn. Applicant's amendments of 3/5/2007 were not considered before the mailing of the final rejection of 3/14/2007 due to the amendments crossing in the mail with the office action mailed 3/14/2007.

### ***Election/Restrictions***

2. The amendments of 3/5/2007 limit the claims to the elected subject matter.

### ***Claim Rejections - 35 USC § 112***

3. The rejection of claims under 35USC 112, first paragraph, as stated in the previous office action is withdrawn due to applicant's amendments in paper dated 3/5/2007.

### **NEW GROUND OF REJECTION**

4. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for making salts of the claimed compounds, does not reasonably provide enablement for making prodrugs of the claimed compounds. The claims contain subject matter, which was not described in the specification in such a way as to enable one of ordinary skill in the art of medicinal chemistry to use the

invention. "The factors to be considered [in making an enablement rejection] have been summarized as a) the quantity of experimentation necessary, b) the amount of direction or guidance presented, c) the presence or absence of working examples, d) the nature of the invention, e) the state of the prior art, f) the relative skill of those in that art, g) the predictability or unpredictability of the art, h) and the breadth of the claims", In re Rainer, 146 USPQ 218 (1965); In re Colianni, 195 USPQ 150, Ex parte Formal, 230 USPQ 546. a) Finding a prodrug is an empirical exercise. Predicting if a certain ester of a claimed alcohol, for example, is in fact a prodrug, that produces the active compound metabolically, in man, at a therapeutic concentration and at a useful rate is filled with experimental uncertainty. Although attempts have been made to predict drug metabolism de novo, this is still an experimental science. For a compound to be a prodrug, it must meet three tests. It must itself be biologically inactive. It must be metabolized to a second substance in a human at a rate and to an extent to produce that second substance at a physiologically meaningful concentration. Thirdly, that second substance must be clinically effective. Determining whether a particular compound meets these three criteria in a clinical trial setting requires a large quantity of experimentation. b) The direction concerning the prodrugs is found in specification, on page . c) There are no working examples of a prodrug of a compound of formula (I). D) The nature of the invention is clinical use of compounds and the pharmacokinetic behavior of substances in the human body. E) Wolff (Medicinal Chemistry) summarizes the state of the prodrug art. Wolff, Manfred E. "Burger's Medicinal Chemistry, 5ed,

part I", John Wiley & Sons, 1995, pages 975-977. The table on the left side of page 976 outlines the research program to be undertaken to find a prodrug. The second paragraph in section 10 and the paragraph spanning pages 976-977 indicate the low expectation of success. In that paragraph, the difficulties of extrapolating between species are further developed. Since, the prodrug concept is a pharmacokinetic issue, the lack of any standard pharmacokinetic protocol discussed in the last sentence of this paragraph is particularly relevant. Banker (Modern Pharmaceutics, 3ed, Marcel Dekker, New York, 1996, pp 451 & 596) teaches in the first sentence, third paragraph on page 596 that "extensive development must be undertaken" to find a prodrug. F) Wolff, in the last paragraph on page 975 describes the artisans making Applicant's prodrugs as a collaborative team of synthetic pharmaceutical chemists and metabolism experts. All would have a PH.D. degree and several years of industrial experience. G) It is well established that "the scope of enablement varies inversely with the degree of unpredictability of the factors involved", and physiological activity is generally considered to be an unpredictable factor. See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). H) The breadth of the claims includes all of the hundreds of thousands of compounds of formula of claim 1 as well as the presently unknown list of potential prodrug derivatives embraced by claim 1.

5. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while maybe enabling for making salts of the claimed compounds, does

not reasonably provide enablement for making solvates of the claimed compounds.

The specification does not enable any person skilled in the art of synthetic organic chemistry to make the invention commensurate in scope with these claims. "The factors to be considered [in making an enablement rejection] have been summarized as

a) the quantity of experimentation necessary, b) the amount of guidance or direction presented, c) the presence or absence of working examples, d) the nature of the invention, e) the state of the prior art, f) the relative skill of those in that art, g) the predictability or unpredictability of the art, h) and the breadth of the claims", *In re*

*Rainer*, 146 USPQ 218 (1965); *In re Colianni*, 195 USPQ 150, *Ex parte Formal*, 230 USPQ

546. In the present case, the important factors leading to a conclusion of undue

experimentation are c) the absence of any working example of a formed solvate, the lack of predictability in the art, and the broad scope of the claims. There are no working

examples of any solvate formed. The claims are drawn to solvates, yet the numerous examples presented all fail to produce a single solvate. These cannot be simply willed

into existence. As was stated in *Morton International Inc. v. Cardinal Chemical Co*, 28

USPQ2d 1190 "The specification purports to teach, with over fifty examples, the preparation of the claimed compounds with the required connectivity.

However...there is no evidence that such compounds exist...the examples of the '881 patent do not produce the postulated compounds...there is ... no evidence that such compounds even exist." The same circumstances appear to be true here. There is no evidence that solvates of the instantly claimed compounds actually exist; if they did,

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they would have been formed. Hence, applicants must show that solvates can be made, or limit the claims accordingly. G) The state of the art is that it is not predictable whether solvates will form or what their composition will be. In the language of the physical chemist, a solvate of an organic molecule is an interstitial solid solution. This phrase is defined in the second paragraph on page 358 of West (Solid State Chemistry). West, Anthony R., "Solid State Chemistry and its Application, Wiley, New York, 1988, pages 358 & 365. The solvent molecule is a species introduced into the crystal and not part of the organic host molecule is left out or replaced. In the first paragraph on page 365, West says, "it is not usually possible to predict whether solid solution will form, or if they do form, what is their compositional extent". Thus, in the absence of experimentation, one cannot predict if a particular solvent will solvate any particular crystal. One cannot predict the stoichiometry of the formed solvate, i.e. if one, two or a half of a molecule of solvent added per molecule of host. In the same paragraph on page 365, West explains that it is possible to make meta-stable non-equilibrium solvates, further clouding what Applicants mean by the word solvate. Compared with polymorphs, there is an additional degree of freedom to solvates, which means a different solvent or even the moisture of the air that might change the stable region of the solvate. H) The breadth of the claims includes all of the hundreds of thousands of compounds of formula (I) as well as the presently unknown list of solvents embraced by the term "solvate". Thus, the scope is broad.

*Allowable Subject Matter*

1. Claims 1-8 are free of prior art.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Margaret Seaman whose telephone number is 571-272-0694. The examiner can normally be reached on 730am-4pm, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Margaret Seaman/  
Primary Examiner  
Art Unit 1625

dms